

REMARKS

Favorable reconsideration and allowance of this application are respectfully requested.

By way of the amendment instructions above, independent claims 1 and 4 have been amended so as to emphasize that the composition of the inner coat includes a **single** pigment consisting of silica. Claim 2 has therefore been canceled as redundant as its subject matter has now essentially been incorporated into the amended version of claim 1.

Claims 1 and 4 further define the "conventional surface coat" as one which includes a pigment component which consists essentially of kaolin and/or calcium carbonate as a pigment. Since the evidence of record clearly establish that silica is a pigment which materially affects the basic and novel characteristics of the presently claimed invention, the use of the preamble expression "consisting essentially of" thereby expressly **excludes** silica as a pigment in such a coat. Support for such revision may be found in the examples of the originally filed specification.

Clarifying amendments have also been made to claims 5 and 6 so as to conform the same to the language now employed in claim 4.

Claim 3 has been revised so as to obviate the Examiner's rejection advanced under 35 USC §112. As such, claims 7 and 8 have been canceled as redundant.

Thus, claims 1 and 3-6 remain pending in this application for which favorable reconsideration and allowance are requested.

The only issue remaining to be addressed in this application is the Examiner's rejection advanced under 35 USC §103(a) based on Kitamura et al.¹

At the outset, applicants are somewhat confused by the Examiner's rejection of claims 1-8 under 35 USC §103(a) as allegedly "obvious" over Kitamura et al. Specifically, the rejection based on Kitamura et al appears to be substantively identical to the rejection advanced by the Examiner in his official action dated June 4, 2003. However, in reply to the Applicants' remarks dated January 20, 2004, the Examiner withdrew his rejection advanced on the basis of Kitamura et al due to "...the conventional surface coat of the [Kitamura et al] reference containing silica and the inner coat not teaching precipitated calcium carbonate." (Official Action dated February 10, 2005 at page 3, paragraph 4.)

Thus, notwithstanding the fact that reference in the pending claims do not explicitly recite that the conventional surface coat is "silica-free", the record herein is abundantly clear that such conventional surface coat composition must necessarily be silica-free as it is for gravure or flexographic printing. Thus, since Kitamura et al is directed to coating for *ink jet* printing – not gravure or flexographic printing as in the present invention – such a conventional coating must necessarily contain silica.²

Notwithstanding the above, the claims pending herein now require the conventional composition to be one having a pigment component which consists essentially of kaolin and/or calcium carbonate as pigment(s), which language of course specifically **excludes** the presence of silica as a pigment.

¹ The inclusion of the substance of claim 2 regarding the composition containing exclusively silica into claim 1 per the amendment instructions above renders moot the rejection advanced against 1 and 3-6 under 35 USC §103(a) based on Werkema (USP 4,575,477).

² The Examiner's attention is again directed to the Escaffre Affidavit submitted with the applicants' response of November 6, 2001 and the remarks of record on this issue, which remarks are expressly incorporated hereinto by reference.

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Therefore, since the surface coat of the present invention is a "conventional composition" which necessarily is silica-free (i.e., since the surface coat is capable of being printed by gravure or flexographic printing) and since Kitamura et al necessarily requires silica to be present in the surface coat (i.e., since Kitamura et al is directed to ink jet printing), the claims pending herein cannot be rendered obvious under 35 USC §103(a) based on Kitamura et al.

Withdrawal of the rejection advanced against the claims pending herein under 35 USC §103(a) based on Kitamura et al is therefore in order.

Should any small matters remain outstanding, the Examiner is encouraged to telephone the Applicants' undersigned attorney so that the same may be resolved without the need for an additional written action and reply.

An early and favorable reply on the merits is awaited.

Respectfully submitted,

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